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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/788,475

02/21/2001

Jerre Wayne Mohler

FWS-3667

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7590

11/03/2003

E. Philip Koltos
Division of General Law Office of the Solicitor
U.S. Department of the Interior
1849 C Street NW ,
Washington, DC 20240

EXAMINER

MORAN, TIMOTHY J

ART UNIT

PAPER NUMBER

2878

DATE MAILED: 11/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/788,475

Applicant(s)

MOHLER, JERRE WAYNE

Examiner

Timothy J. Moran

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-5 is/are allowed.
- 6) ☒ Claim(s) 1,2 and 6-9 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 11-12, the term "an achromatic lens along a line of sight and the longpass filter or the barrier filter" is unclear since it is unclear how a lens can be "along" a line of sight and "along" a filter simultaneously.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Coates, U. S. Patent No. 4,884,890. Regarding claim 1, Coates describes a device (fig. 1) for detecting visible fluorescence comprising a light source (10), an exciter filter (14), a dichroic beamsplitter (16, col. 2, lines 27-35), a barrier filter (24) and an achromatic lens (26) along a line of sight comprising the barrier filter. Here the term "achromatic lens" is understood to mean "a lens which transmits light of various wavelengths equally well."

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Regarding claim 2, Coates describes the use of a mercury lamp (col. 2, lines 27-35).

Regarding claim 6, Coates describes a method for examining a sample comprising contacting a sample with light transmitted through a dichroic beamsplitter (16, col. 2, lines 27-35), and observing light emitted from the sample and transmitted light through a barrier filter (24). Regarding the term "fluorochrome," the description of the sample as "fluorescent" (see abstract) is understood to imply that the sample comprises a fluorochrome.

Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Metz, U. S. Patent No. 5,166,813. Metz describes a method for examining a sample comprising contacting a sample with light transmitted through a dichroic beamsplitter (14, col. 9, lines 45-53), and observing light emitted from the sample through a barrier filter (24). Regarding the term "fluorochrome," the description of the sample as "fluorescent" (see abstract) is understood to imply that the sample comprises a fluorochrome.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coates or Metz as applied to claim 6 above, and further in view of Chu, U. S. Patent No. 5,440,927. Chu describes a method for examining a sample to detect fluorescence

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where calcein (col. 4, lines 13-30) is used as a fluorochrome to enable moisture detection. Therefore it would have been obvious to one of ordinary skill in the art to use calcein together with the methods of Coates or Metz to enable moisture detection.

Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coates or Metz as applied to claim 6 above, and further in view of Eckstrom, U. S. Patent No. 5,324,940. Coates and Metz do not teach use of fluorescence detection with live animals. However, Eckstrom teaches that fluorescence detection of live fish is useful for identification purposes. Therefore, it would have been obvious to one of ordinary skill in the art to use the detection method of Coates or Metz to analyze live animals such as salmon for the advantages of accurate identification.

Allowable Subject Matter

Claims 3-5 are allowed.

Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Claim 3 includes the limitations that a fluorescence detection device comprises a light guide, an excitation or bandpass filter, a dichroic beamsplitter, and a separate longpass filter or barrier filter. Claim 10 includes the limitations that a barrier filter located in eyeglasses is used with a beamsplitter to analyze a live animal specimen.

Response to Arguments

Applicant's arguments filed October 9, 2003 have been fully considered but they are not persuasive.

In response to applicant's argument (page 6, paragraph starting with "This rejection...") that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., microscope for magnifying images) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument (paragraph spanning page 6 and page 7) that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., holographic barrier filter not being required) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's arguments in the second complete paragraph and the last complete paragraph on page 7 fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant's arguments in the second complete paragraph on page 8 fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the

claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Moran whose telephone number is 703-305-0849. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Porta can be reached on 703-308-4852. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9318 for regular communications and 703-872-9319 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

T.M.

TM
October 28, 2003



DAVID PORTA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800